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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,257	02/22/2005	Thomas Aue	SCH-15904	5004
40854	7590	01/23/2009	EXAMINER	
RANKIN, HILL & CLARK LLP			NIA, ALIREZA	
38210 Glenn Avenue				
WILLOUGHBY, OH 44094-7808			ART UNIT	PAPER NUMBER
			3739	
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			01/23/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/525,257	AUE, THOMAS	
	<b>Examiner</b>	<b>Art Unit</b>	
	ALIREZA NIA	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 October 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-14 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 22 February 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>11/13/08</u> .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30<sup>th</sup>, 2008 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller 5,807,240.**

4. Muller '240 discloses a urological resectoscope 10 comprising a main body 50, a guide 22 of a slide carriage 12 being permanently and directly affixed to and proximally extending from said main body 50 (fig. 1b), an inner shaft 32 for feeding fluid via 44,68, and an outer shaft 30,34 for removing fluid via the space 70 between the inner 32 and outer 30,34 shafts, both shafts extending distally from the main body (col. 3, lines 17-37), said outer shaft 30,34 enclosing said inner shaft 32, and an optics 14 traversing the main body 50 and the inner shaft 32 wherein the outer shaft 30,34 is directly connectable to the main body 50 by an externally actuated outer connector element 42,52 (col. 2, lines 18-67, col. 3, lines 1-67, figs. 1a,1b).

Muller '240 further discloses the inner shaft 32 is affixed to the main body 50 (col. 2, lines 56-57, fig. 1b). Muller '240 further discloses the inner shaft 32 is affixed in a borehole of the main body (fig. 1b). Muller '240 also discloses the inner shaft 32 is affixed to a proximal terminal zone 42 of the outer shaft 30,34 (fig. 1b).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. *Claims 3, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller 5,807,240 in view of Muller 5,486,155.***

7. Muller '240 discloses the invention as discussed above. However, Muller '240 fails to positively disclose an inner connector element detachably affixing the inner shaft to the main body. Muller '240 also fails to positively disclose an inner connector element that detachably affixes the inner shaft to a proximal terminal zone of the outer shaft. Muller '240 also fails to positively disclose a connector element comprised by the inner shaft, the connector element engaging the outer connector element between the outer shaft and the main body.

8. Muller '155 teaches an inner connector element 58 in an analogous resectoscope, the inner connector element 58 detachably affixing an inner shaft to a main body (fig. 3A). Muller '155 also teaches an inner connector element 64 that detachably affixes an inner shaft 54 to a proximal terminal zone of an outer shaft 50 (fig. 3A). Also, Muller '155 teaches a connector element 62,86 on an inner shaft, the connector element 62,86 engaging an outer connector

element 60,96 (figs. 3A,3B), resulting in an improved endoscope having a rotatable connection of an inner sheath with respect to a working element mitigating damage caused to tissue when the device is rotated inside a patient's body (col. 1, lines 21-22 et seq. lines 36-39).

9. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the resectoscope of Muller '240 with the above discussed limitations as taught by Muller '155 in order to have provided an improved endoscope having a rotatable connection of an inner sheath with respect to a working element mitigating damage caused to tissue when the device is rotated inside a patient's body, facilitating better flexibility, maneuverability, and efficiency during complex surgical procedures for a surgeon without the risk of harming critical areas within a cavity of a patient.

**10. Claims 8, 9, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller 5,807,240 in view of Kubota 4,538,610.**

11. Muller '240 discloses a urological resectoscope 10 comprising a main body 50, a guide 22 of a slide carriage 12 being permanently and directly affixed to and proximally extending from said main body 50 (fig. 1b), an inner shaft 32 for feeding fluid via 44,68, and an outer shaft 30,34 for removing fluid via the space 70 between the inner 32 and outer 30,34 shafts, both shafts extending distally from the main body (col. 3, lines 17-37), said outer shaft 30,34 enclosing said inner shaft 32, and an optics 14 traversing the main body 50 and the inner shaft 32 wherein the outer shaft 30,34 is directly connectable to the main body 50 by an externally actuated outer connector element 42,52 (col. 2, lines 18-67, col. 3, lines 1-67, figs. 1a,1b). Muller '240 further discloses the inner shaft 32 is affixed to the main body 50 (col. 2, lines 56-57, fig. 1b). Muller '240 further discloses the inner shaft 32 is affixed in a borehole of the main

body (fig. 1b). Muller '240 also discloses the inner shaft 32 is affixed to a proximal terminal zone 42 of the outer shaft 30,34 (fig. 1b).

12. However, Muller '240 fails to positively disclose finger grips directly affixed to and extending from said main body.

13. Kubota teaches finger grips directly affixed to and extending from a main body 16 of an analogous resectoscope 1 (fig. 1, col. 5, lines 63-68), resulting in an improved resectoscope for insertion into a bladder via a urethra, wherein an electrode at the rear end can be electrically connected with an electrode cord at the tip with a simple structure wherein an operator has no danger of being electrified and is high in safety (col. 2, lines 50-56).

14. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the resectoscope of Muller '240 with the above discussed limitations as taught by Kubota in order to have provided an improved and safe resectoscope for insertion into a bladder via a urethra, wherein an electrode at the rear end can be electrically connected with an electrode cord at the tip of the resectoscope with a simple structure wherein an operator has no danger of being electrified by insulating and distancing the operator's direct contact with the electrode and housing.

**15. Claims 10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller 5,807,240 in view of Kubota 4,538,610 further in view of Muller 5,486,155.**

16. Muller '240 in view of Kubota discloses the invention as discussed above. However, Muller '240 in view of Kubota fails to positively disclose an inner connector element detachably affixing the inner shaft to the main body. Muller '240 in view of Kubota also fails to positively disclose an inner connector element that detachably affixes the inner shaft to a proximal terminal

zone of the outer shaft. Muller '240 in view of Kubota also fails to positively disclose a connector element comprised by the inner shaft, the connector element engaging the outer connector element between the outer shaft and the main body.

17. Muller '155 teaches an inner connector element 58 in an analogous resectoscope, the inner connector element 58 detachably affixing an inner shaft to a main body (fig. 3A). Muller '155 also teaches an inner connector element 64 that detachably affixes an inner shaft 54 to a proximal terminal zone of an outer shaft 50 (fig. 3A). Also, Muller '155 teaches a connector element 62,86 on an inner shaft, the connector element 62,86 engaging an outer connector element 60,96 (figs. 3A,3B), resulting in an improved endoscope having a rotatable connection of an inner sheath with respect to a working element mitigating damage caused to tissue when the device is rotated inside a patient's body (col. 1, lines 21-22 et seq. lines 36-39).

18. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the resectoscope of Muller '240 in view of Kubota with the above discussed limitations as taught by Muller '155 in order to have provided an improved endoscope having a rotatable connection of an inner sheath with respect to a working element mitigating damage caused to tissue when the device is rotated inside a patient's body, facilitating better flexibility, maneuverability, and efficiency during complex surgical procedures for a surgeon without the risk of harming critical areas within a cavity of a patient.

***Response to Amendment***

19. The amendment to claim 1 and the addition of new claims 8-14 in the response filed on October 30<sup>th</sup>, 2008 is acknowledged.

20. Claims 1-14 are now pending in the application.

***Response to Arguments***

21. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

22. With respect to Applicant's argument that "*Regarding claim 1, the Examiner states that in Muller '240 the inner sheath frame 50 should be considered the equivalent of applicant's claimed main body. This is instead of the frame 22 of Muller '240. The inner sheath frame 50 is not the same as a main body and Applicant has amended the claims to clearly distinguish these two items. Applicant states that the guide of the claimed slide carriage is 'permanently and directly affixed' to the main body.*" The Examiner respectfully disagrees with Applicant. In claim 1, no structure has been recited in order to further limit and narrow the broadness of the term "main body". Therefore, as broadly as claim 1 has been recited, reference number 50 of Muller '240 is construed by the Examiner to be a main body 50 and thus, a guide 22 of a slide carriage 12 is permanently and directly affixed to and proximally extending from said main body 50 as shown in fig. 1b of Muller '240. The rejection of claim 1, 2, 4, and 5 stand rejected under 35 U.S.C. §102(b) as being anticipated by Muller 5,807,240 (see rejection supra).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALIREZA NIA whose telephone number is (571)270-3076. The examiner can normally be reached on Mo.-Fri.-7:30 AM-5:00 PM EST-Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. N./  
Examiner, Art Unit 3739  
Alireza Nia  
January 12<sup>th</sup>, 2009

/Linda C Dvorak/  
Supervisory Patent Examiner, Art Unit 3739